

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTORS: Stephen R. Lawrence et al.

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TITLE: Systems and Methods of Synchronizing Indexes

EXAMINER: Verdi, KimbleAnn C.

GROUP ART UNIT: 2194

ATTY. DKT. NO.: 24207-10094

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Dated: June 2, 2009 By: Jie Zhang/
Jie Zhang, Reg. No. 60,242

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(b)

SIR:

This letter is to request reconsideration of the Patent Term Adjustment (PTA) under Rule 37 C.F.R. § 1.705(b). Specifically, in view of *Wyeth v. Dudas*, 580 F. Supp. 2d 138 (D. D.C. 2008), the PTA calculation does not account for the total period of delay under Rules 702(a) and 702(b) (adjusted by any delay accorded to Applicant under Rule 704 and any delay accorded to overlapping days under Rule 703(a) and Rule 703(b)). The \$200 fee required by Rule 18(e) is authorized herewith. The calculation of the corrected PTA and the bases for the adjustment are provided below.

Although a patent has not yet issued, Applicants submit this request prior to payment of the issue fee pursuant to Rule 705 because Applicants believe the PTA calculation in the Notice of Allowance is incorrect. If the Office decides to hold this request in abeyance, pending issuance of the patent, Applicants concur with that decision.

Calculation of Periods for Patent Term Adjustment

Under Rule 703(a)

The PTO determined it incurred 832 days of delay under Rule 703(a) for the period beginning 14 months from the filing date (June 1, 2005) until the mailing of a Non-Final Rejection on September 10, 2007. Applicants calculate the relevant period to be from June 1, 2005 to September 10, 2007, and agree with the determination that the PTO incurred 832 days delay under 703(a). Applicants reserve the right to request additional PTA under Rule 703(a) in the event the PTO does not timely issue the instant patent following payment of the issue fee.

Under Rule 703(b)

The application was filed on March 31, 2004, and the period exceeding three years after the date on which the application was filed begins on April 1, 2007 (three years from the day after the filing date). Currently, Applicants calculate the relevant period to be from April 1, 2007 to March 16, 2009 (the date referenced in Form PTOL-85), or 716 days, although a patent has not yet issued.

Reduction Under Rule 704

The PTO determined 91 days of Applicant delay, due to the following days in excess of three months taken to respond to the Notice from the Office: December 11, 2007 to January 10, 2008, and July 1, 2008 to August 29, 2008. Applicants do not dispute the PTO determination of 91 days of Applicant delay.

Request for Patent Term Adjustment in View of *Wyeth v. Dudas*

In the PTOL-85 mailed March 16, 2009, the PTO calculated that Applicants are entitled to 741 days of PTA as the difference between the delay under Rule 702(a) and the Applicant delay under Rule 704. According to *Wyeth v. Dudas*, 580 F. Supp. 2d 138 (D. D.C. 2008), the Patent Term Adjustment statute (35 U.S.C. § 154) does not permit the PTO to excuse one source of delay simply because it caused another source of delay by interpreting delays under Rule 703(a) and Rule 703(b) to be overlapping when such delays do not occur on the same calendar

days. Therefore, Applicant requests the PTA be based on the sum of delays under Rules 703(a) and 703(b).

Applicants believe that the delays under Rules 703(a) and 703(b) in this case are overlapping 163 days on the same calendar days. In other words, the PTO delay from June 1, 2005 to September 10, 2007 (delay under Rule 703(a)) overlaps with the PTO delay from April 1, 2007 to March 16, 2009 (delay under Rule 703(b)). Therefore, Applicant requests the PTA calculation be based on the sum of delays under Rules 703(a) and 703(b) minus the days of Applicant delay, and further minus the overlapping days under Rule 703(a) and Rule 703(b), yielding a calculation of $832 + 716 - 91 - 163 = 1294$ days.

Applicant reserves the right to request additional PTA in the event the PTO does not timely issue the instant patent following payment of the issue fee.

No Terminal Disclaimer

This application is not subject to a terminal disclaimer.

AUTHORIZATION

The Commissioner is hereby authorized to charge the fee set forth in 37 C.F.R. § 1.18(e) to Deposit Account No. 19-2555. The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this communication, or credit any overpayment, to Deposit Account No. 19-2555.

Respectfully submitted,
STEPHEN R. LAWRENCE ET AL.

Dated: June 2, 2009

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